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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/817,196   | 04/02/2004  | Nikhil Jain          | 030260              | 2171             |
| 23696  | 7590        | 10/20/2005           | EXAMINER            |                  |
| QUALCOMM, INC<br>5775 MOREHOUSE DR.<br>SAN DIEGO, CA 92121 |             |                      | NGUYEN, DAVID Q     |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 2681                |                  |

DATE MAILED: 10/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                             |                  |  |
|------------------------------|-----------------------------|------------------|--|
| <b>Office Action Summary</b> | Application No.             | Applicant(s)     |  |
|                              | 10/817,196                  | JAIN ET AL.      |  |
|                              | Examiner<br>David Q. Nguyen | Art Unit<br>2681 |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

- 1) Responsive to communication(s) filed on 22 April 2004.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

- 4) Claim(s) 1-10 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-5,8 and 10 is/are rejected.
- 7) Claim(s) 6,7 and 9 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

|  |  |
|--|--|
| <ol style="list-style-type: none"> <li>1)<input checked="" type="checkbox"/> Notice of References Cited (PTO-892)</li> <li>2)<input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</li> <li>3)<input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br/>Paper No(s)/Mail Date _____.</li> </ol> | <ol style="list-style-type: none"> <li>4)<input type="checkbox"/> Interview Summary (PTO-413)<br/>Paper No(s)/Mail Date. _____.</li> <li>5)<input type="checkbox"/> Notice of Informal Patent Application (PTO-152)</li> <li>6)<input type="checkbox"/> Other: _____.</li> </ol> |
|--|--|

## **DETAILED ACTION**

### ***Specification***

1. The disclosure is objected to because of the following informalities:

All co-pending applications must be identified by their application numbers

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-5,8 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Persson et al. (US 6,144,653).

Regarding claim 1, Persson et al. discloses a method of wireless communications between a first network and a second network enabling a mobile station (MS) subscribed in the first network to communicate using the second network, comprising: storing an identity of the mobile station (see col. 54, lines 30-36); obtaining authentication information from the first network based on the identity of the mobile station (see col. 55, lines 10-34); using the authentication information from the first network to create a key (see col. 55, lines 10-34); substituting the key for an authentication key used in a first algorithm to authenticate the mobile station (see col. 55, lines 10-34); and substituting the key for an encryption key used in a second

algorithm to encrypt messages between the mobile station and the second network (see col. 55, lines 10-34).

Regarding claims 2-5 and 8, Persson et al. also discloses wherein the created key is from the first network (see col. 55, lines 10-34); wherein the first algorithm is executed in the second network (see col. 55, lines 10-34); wherein the authentication key is SSD-A (see col. 53, lines 5-10; col. 55, lines 10-34); wherein the encryption key is SSD-B; wherein the first algorithm is a CAVE algorithm (see col. 53, lines 5-10; col. 55, lines 10-34 and figs. 31-37).

Regarding claim 10, Persson et al. also discloses a mobile station, comprising: means for receiving a key from a first network (see col. 54, lines 30-36 and col. 55, lines 10-34); means for substituting the first network key for an authentication key used in a first algorithm to authenticate the mobile station (see col. 54, lines 30-36 and col. 55, lines 10-34); and means for substituting the key for an encryption key used in a second algorithm to encrypt messages between the mobile station and a second network (see col. 54, lines 30-36 and col. 55, lines 10-34).

#### *Allowable Subject Matter*

4. Claims 6-7 and 9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Regarding claims 6-7, Persson et al. does not mention the first network is a GSM network and wherein the second network is a CDMA network.

#### *Conclusion*

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Mizikovsky (US 6,839,434 B1 ) discloses a method and apparatus for performing a key update using bidirectional validation.

Fehnel (US 5,887,251) discloses authentication key management for mobile stations.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Q. Nguyen whose telephone number is 571-272-7844.

The examiner can normally be reached on 8:30AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JOSEPH H. FEILD can be reached on (571)272-4090. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DN  
David Nguyen

  
JOSEPH FEILD  
SUPERVISORY PATENT EXAMINER